

**REMARKS**

Claims 1-39 are all the claims presently pending in the application. New claim 39 is merely existing dependent claim 6 written in independent format, and amendments to claims 1 and 4 are merely a partial incorporation of existing dependent claim 4 into claim 1. The claim amendments to claims 25 and 26 incorporate wording provided by the Examiner as overcoming the statutory subject matter rejection. Therefore, no new issues are raised by these amendments or the new claim, so entry of this amendment is proper under 37 CFR §1.116.

It is noted that Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 25 and 26 stand rejected under 35 U.S.C. §101 as directed toward statutory subject matter. Although Applicants disagree with the Examiner's interpretation of the law relative to this rejection, in the interest of expedited prosecution, Applicants have reworded these two claims consistent with the Examiner's interpretation, and respectfully request that the Examiner reconsider and withdraw this rejection.

Claims 23, 25, 27, 29-32, 35, and 36 stand rejected under 35 U.S.C. § 102(e) as anticipated by US Patent 7,213,234 to Below et al.

Claims 1-22, 37, and 38 stand rejected under 35 U.S.C. §103(a) as unpatentable over Ramil et al., "Cost Estimation and Evolvability Monitoring for Software Evolution Processess", and claims 24, 26, 28, 33, and 34 stand rejected under 35 U.S.C. §103(a) as unpatentable over Below, further in view of Ramil.

Although Applicants maintain their earlier positions stated in their previous response, Applicants particularly disagree that the evaluation of record reasonably demonstrates the content of dependent claim 4, and has partially incorporated this language into independent claim 1. New independent claim 39 even precisely defines the present invention in terms of this very narrow aspect.

Therefore, Applicants again respectfully traverse these rejections, particularly relative to the rejection for dependent claims 4 and 6, as per the following discussion.

## I. THE CLAIMED INVENTION

As exemplarily described in, for example, independent claim 1, the claimed invention is directed to a method of estimating a cost related to at least one of computer software development, computer software maintenance, and information technology services. A sample of computer code is read in accordance with a sampling technique and at least one sampling is categorized. A cost for a larger subset of the computer code from the sampling is calculated. At least one of the reading, the sampling, and the calculating is executed on a computer.

As explained beginning at line 4 on page 3 of the specification, estimating costs for modifications to existing software, such as porting, as well as other activities related to existing software such as maintenance, application portfolio management, and legacy transformation of software, typically requires a comprehensive investigation including scanning the entire set of code to look for potential problems. This comprehensive approach can be very expensive and time consuming.

The claimed invention, on the other hand, teaches a novel method to estimate such costs by deriving a cost estimate using a sampling of the code.

## II. THE PRIOR ART REJECTIONS

The Examiner alleges that claims 23, 25, 27, 29-32, 35, and 36 are anticipated by Below, that claims 1-22, 37, and 38 are unpatentable over Ramil, and that claims 24, 26, 28, 33, and 34 are unpatentable over Below, further in view of Ramil.

Applicants again respectfully disagree. Although Applicants still maintain their earlier comments about the rejections of record, in an effort to expedite prosecution, dependent claim 4 has been partially incorporated into independent claim 1 and new claim 39 has very narrowly defined the present invention in language of this aspect.

As best understood, in the rejection of record for original claim 4, the Examiner relies upon “stratified sampling” described line 62 of column 3 through line 2 of column 4 of Below. However, “stratified sampling” is a term of art, as evidenced that claim 7 specifically mentions this method and as described beginning at line 17 on page 21 of the present Application.

In contrast to reference to “stratified sampling” listed as the final method of claim 7, the language of claim 4 clearly addresses the different method of categorizing based upon difficulty. This concept of “categorizing” is separately described in the present application,

for example, at line 9 of page 15 through line 7 of page 16.

Therefore, given that the present application clearly distinguishes between these two concepts and even has separate claims directed to the two concepts, Applicants respectfully submit that the rejection of record for original claims 4 and 6 are improper as a matter of law, since the Examiner's interpretation of this claim terminology would be inconsistent with the meaning of the specification. As explained in MPEP §2111, the Examiner's broadest reasonable interpretation of claim terminology cannot be inconsistent with the meaning in an applicant's own specification.

Accordingly, Applicants respectfully submit that the rejection currently of record fails to reasonably demonstrate this element of the claimed invention, even if the Examiner is given the benefit of the doubt for the remainder of the rejection.

Hence, turning to the clear language of the claims, in Ramil even if modified by Below, there is no teaching or suggestion of: "... categorizing at least one computer sampling", as required by independent claim 1. Nor is there any suggestion of: "... wherein said categorizing at least one computer sampling comprises categorizing each computer sampling into one of N categories of difficulty, N being an integer greater than 1", as required by dependent claim 4. Moreover, dependent claim 6 and new claim 39 would also clearly be patentable over Ramil/Below.

### **III. FORMAL MATTERS AND CONCLUSION**

In view of the foregoing, Applicant submits that at least some of claims 1-39 are patentably distinct over the prior art of record and are in condition for allowance and that other claims could be easily placed into condition for immediate allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/721,242  
Docket No. YOR920030297US1 (YOR.479)

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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**CERTIFICATION OF TRANSMISSION**

I certify that I transmitted via EFS this Response under 37 CFR §1.116 to Examiner B. Wang on March 10, 2008.



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